

### Remarks

Claims 10, 12, 13, and 16-24 were previously pending in the application. After entry of the response Claims 10, 12, 13, and 16-24 will be pending. Reconsideration is respectfully requested based on the following remarks.

Preliminarily, Applicants note that in a telephone communication with the Examiner conducted on December 31, 2008, the Examiner indicated that box 8 of the Office Action Summary indicating that various claims are subject to restriction and/or election requirement was mistakenly checked and that box 6 of the Office Action Summary indicting the rejection of various claims should have been checked.

### Claim Rejection 35 U.S.C. §112

Claims 10, 12, 13, and 16-24 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description and/or enablement requirement.

Claims 10, 12, 13, and 16-24 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In regard to the various §112, first and second paragraph rejections, Applicants respond as follows:

In Claim 10 Applicants have replaced the term “disconnected” with the phrase “not directly physically connected to” as interpreted by the Examiner (see page 8 of the Office Action).

Applicants have replaced the term “DC” throughout the pending claims with the phrase “direct current”.

In Claim 17, Applicants have replaced the phrase “an externally provided DC input voltage” with the phrase “provide a direct current voltage”.

As for Claim 19 reciting “a third DC output voltage” and the lack of antecedent basis therefore, Claim 10 recites a first direct current output voltage and a second direct current output voltage.

Applicants have amended Claim 23 to recite a “reverse bias direction” and a “forward bias direction”.

In regard to Claim 10, the Examiner indicated that the specification requires, “The multiple output DC/DC voltage converter comprises a transformer having a primary coil applied with the input DC voltage and at least two more secondary coils.”

As indicated previously by Applicants, the inventor is not required to set forth in the specification every manner of practicing his invention. He is only required to show the best mode known to him of utilizing the invention. Patent drafters sometimes refer to the description of a particular described use of the invention as a “preferred embodiment”. As a general rule, the claims are not limited to the preferred embodiment nor is the inventor obligated to claim the preferred embodiment.

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.

In this regard, Applicants made it very clear in the specification that the critical feature of Applicants' invention was an apparatus having the combined features of the "choke" method and the "fly-back" method, not that the "fly-back" method absolutely required one, two, three, or more secondary coils.

As for any terms or phrase that may be used in the claims and that don't appear in the specification, i.e., the first rectifier circuit not directly physically connected, direct current, etc., Applicants respectfully submit, that an application need not contain a word-for-word description of the claimed invention to satisfy the written description requirement (i.e., the claims of the invention need not be identically written in the disclosure of the application). All that is required is that the application reasonably conveys the claimed subject matter. *Ex parte Parks*, 30 USPQ 2d 1234 (B.P.A.I. 1994) Further in this regard, the drawings may be used to supplement the written description. A drawing, defined as a visual representation of something made by lines on a surface, may by itself constitute a written description of the invention if it reasonably conveys to one of ordinary skill that the inventor possessed the invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F2d. 1555, 19 USPQ 2d 1111 (Fed. Cir. 1991)

“Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing . . .” *In re Wofensperger*, 49 C.C.P.A. 1075, 302 F.2d 950, 133 USPQ (BNA) 537 (1962)

As such, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first and second paragraphs.

#### Double Patenting

Claims 10, 12, 13, and 16-24 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-14 of U.S. Patent No. 6,275,208.

The conflicting ‘208 patent and the present application are commonly owned and Applicants have included herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) to overcome an actual or provisional rejection based on a nonstatutory double patenting ground.

#### Claim Rejection 35 U.S.C. §102

Claims 10, 12, 13, and 16-24 were rejected under 35 U.S.C. §102(b) as being anticipated by Clark et al. (U.S. Patent No. 4,323,957), herein referred to as “Clark”.

Of the above-referenced claims, Claim 10 is independent. Accordingly, once allowability of this claim is established, all claims depending therefrom are likewise allowable.

Claim 10 has been amended to recite, “a first rectifier circuit connected to the primary coil to generate a first direct current output voltage, the first rectifier circuit not directly physically connected to the first secondary coil”.

Based at least on the remarks provided above and as shown in Applicants' Figure 6, Applicants respectfully submit that the limitation of "the first rectifier circuit is not directly physically connected to the first secondary coil" is described in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In contrast to Applicants' claimed subject matter, Clark does not disclose, teach, or otherwise suggest "a first rectifier circuit connected to the primary coil to generate a first direct current output voltage, the first rectifier circuit not directly physically connected to the first secondary coil" as recited in Applicants' Claim 10. Although switching off transistors 62 and 72 may electrically disconnect the voltage suppression circuit 70 from the first secondary coil 16b at point 36, the circuit is still directly physically connected to the first secondary coil.

For at least this reason, Applicants respectfully submit independent Claim 10, and all claims depending therefrom are patentable.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b).

#### Claim Rejections 35 U.S.C. §103

Claims 13, 16, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark, in view of Liu et al. (U.S. Patent No. 5,808,879), herein referred to as "Liu".

Claims 20-23 are rejected were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark in view of the Instant Application's Admitted Prior Art (APA).

For at least the reasons set forth above in regard to Claim 10, Applicants respectfully submit all claims depending therefrom are patentable.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

Conclusion

In view of the remarks set forth above, it is submitted that the application is now in condition for allowance. Authorization is given to charge any fees due or credit any overpayments in regard to this communication to deposit account 50-2257. If the Examiner has any questions or concerns, a telephone call to the undersigned at (949) 752-7040 is welcomed and encouraged.

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Respectfully submitted,



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